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09/880,693	06/13/2001	Arvind Rangaswamy	823.0058USU	4299

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EXAMINER

BYLCIW, STEPHEN

ART UNIT PAPER NUMBER

3623

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/880,693

Applicant(s)

RANGASWAMY ET AL.

Examiner

Stephen Bylcw

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This non-final office action is in response to the patent application filed in the United States on June 8, 2001. Claims 1-22 are pending.

### **Examiner's Note**

2. In claim 21 the applicant uses "means for" terminology and may invoke 35 U.S.C. § 112, paragraph 6. The examiner assumed the applicant did not intend to invoke 35 U.S.C. § 112, paragraph 6. If the applicant requests an examination considering 35 U.S.C. § 112, paragraph 6, please provide the specific page(s) and line number(s) within the specification that describe the relevant claimed structure, material, or acts.

### ***Claim Objections***

3. Claim 5 is objected to because of the following informality: "feed back" should be replaced with "feedback." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 9-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts. Further, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. In the present case, the rejected claims fail to apply, involve, use, or advance the technological arts. An example:

a) Independent claim 9 recites a method of conducting a plurality of benchmarking studies that includes the steps of conducting interactive sessions, building a file, providing... feedback of comparative data, and processing the answer data. These steps as claimed do not incorporate technology that would give them patentable weight such as conducting online interactive sessions using computers networked via the Internet. As a result, this claim is non-statutory as well the dependent claims 10-20.

While claims 9-20 produce a useful, concrete, and tangible result, they are deemed to be non-statutory for failing to apply, involve, use, or advance the technological arts. In order to overcome this rejection it is respectfully suggested that the claims be amended to expressly incorporate technology (i.e., a computer processor, exchanging information over an online computer network) as performing at least one of the core steps of the invention. . Appropriate correction is required.

EXAMINER'S NOTE: Examiner interprets "online" in the context of the claims to involve the use of multiple computers connected via the Internet and thus claims 1-8 were deemed acceptable subject matter under 35 USC § 101.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 9-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 9-22 recite the limitation "...providing to the a first respondent of a first one of said studies during said interactive session a feedback..." There is insufficient antecedent basis for this limitation in this independent claim as there is no previous mention of an interactive session. Claims 10-20 are rejected because they are dependent on claim 9. For the purposes of examination, the claim is interpreted with the term "said interactive session" in the limitation replaced with "said interactive sessions." Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

**9. Claims 1-4 and 7-8 are rejected under 35 U.S.C. 102(a) and 102(e) as being anticipated by Machin (U.S. Patent 6,877,034).**

Regarding claim 1, Machin teaches an online benchmarking (survey) system and method that enables a company to identify peer companies (suitable survey respondents), complete an evaluation, and receive a comparison report outlining differences for various performance categories. The system and method includes:

- Conducting interactive online sessions with a plurality of respondents who supply responses from a questionnaire (column 2, lines 18-21; column 3, lines 41-47; column 5, line 24).
- Building a database with questionnaire responses (column 2, lines 20-21; column 14, lines 36-39).
- Providing benchmarking reports utilizing response data upon request (column 1, line 66 to column 2, line 2; column 9, lines 46-48).

Regarding claim 2, Machin teaches an online benchmarking (survey) system and method that provides benchmarking reports online (column 10, lines 30-31; column 13, lines 37-39). Examiner interprets e-mail to be messages transmitted online between computers via the Internet.

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Regarding claim 3, Machin teaches an online benchmarking (survey) system and method that provides benchmarking reports only to authorized requestor(s) (column 4, lines 31-32).

Regarding claim 4, Machin teaches an online benchmarking (survey) system and method that provides online instant/ real-time feedback to one of the respondents (column 13, lines 37-39).

Regarding claims 7-8, Machin teaches an online benchmarking (survey) system and method that saves a partially completed set of questionnaire answers and presents this partially completed set in a subsequent session (column 5, lines 35-38).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Machin (U.S. Patent 6,877,034) as applied to claims 1-4 above and in further view of Lo (U.S. Patent Application Publication 2002/0031755).**

Regarding claim 5, Machin teaches an online benchmarking (survey) system and method. It stores respondent data in an online database that is copied to a mirror database during a specified time and on a regular basis (column 7, lines 43-45). The mirror database performs the comparative analysis (column 10; lines 51-53) and

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distributes reports. The invention includes the capability to manipulate and mine data contained in the database real-time so as to generate tailored informative reports (column 13, lines 37-39).

Machin does not expressly teach providing instant feedback when questionnaire is completed.

Lo teaches providing instant feedback when the test (questionnaire, poll, benchmarking survey) is completed (page 2, column 2, lines 17-19). Machin and Lo are analogous art of evaluating the performance of respondents via testing (questionnaires, polls, benchmarking surveys). It would be obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Machin and Lo to produce a system and method that provides results immediately after a test (questionnaire, benchmarking survey) is completed for advantage of eliminating delays.

**12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Machin (U.S. Patent 6,877,034) in view of Lo (U.S. Patent Application Publication 2002/0031755) as applied to claim 5 above, and further in view of "MECON Announces..." (1999).**

Regarding claim 6, Machin teaches an online benchmarking (survey) system and method and Lo teaches providing instant feedback only when the test (benchmarking survey) is completed. Machin and Lo do not teach instantaneous feedback that includes comparative data relative to the other respondents.



MECON teaches instantaneous feedback relative to other respondents including comparative data (lines 4-10). Machin, Lo, and MECON are analogous art of evaluating the performance of respondents via testing (questionnaires, polls, benchmarking surveys). It would be obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Machin, Lo, and MECON to produce a system and method that provides comparative result data immediately after a test (questionnaire, benchmarking survey) is completed for the advantage of eliminating delays.

**13. Claims 9 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machin (U.S. Patent 6,877,034).**

Regarding Claim 9, and 21-22, Machin teaches an online benchmarking (survey) system and method that:

- Allows for a plurality of benchmarking studies (column 7, lines 14-17... teaches various studies can be configured using different sets of peer groups; column 13, lines 37-39... teaches the user could perform various studies on the benchmarking data; column 3, lines 34-39... invention can benchmark various business types; column 4, lines 12-13... users can initiate a study).
- Allows for different questionnaires to be administered for each of the studies (column 5, lines 25-26) differing in content (column 5, lines 25-26) and format (column 5, lines 33-34).
- Identifies a common data structure (column 6, lines 3-9... teaches a common data structure limited to three types data: real, nominal, and text).

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- Allows for one of more databases (database files) to store benchmarking data from the respondents (column 3, lines 61-63).
- Providing to a first respondent of a study the feedback containing comparative data from a question a later respondent has answered (column 9, lines 46-48; column 13, lines 37-39).
- Processing the respondent data in the database files by keying on (data mining) the data structure to produce benchmark reports (column 13, lines 37-39).

Although Machin teaches for more than one database [file] to store benchmarking data, he does not expressly teach building a separate database file for each study.

It is old and well known to one of ordinary skill in the art at the time of invention that information can be allocated into different database files.

It would have been obvious to one of ordinary skill in the art at the time of invention that the system and method taught by Machin can be configured having a separate database file for each study for the advantage of organizational efficiency and speed.

**14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Machin (U.S. Patent 6,877,034) as applied to claim 9 above and in further view of Lo (US Patent application Publication 2002/0031755).**

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Regarding claim 10, Machin teaches an online benchmarking (survey) system and method.

Machin does not expressly teach providing instant feedback when a survey (questionnaire, test form) is completed.

Lo teaches providing instant feedback when the test (questionnaire, poll, benchmarking survey) is completed (page 2, column 2, lines 17-19). Machin and Lo are analogous art of evaluating the performance of entities via tests (questionnaires, polls, benchmarking surveys). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Marchin and Lo to produce a system and method that provides results immediately after a test (questionnaire, benchmarking survey) is completed for advantage of eliminating delays.

**15. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machin (U.S. Patent 6,877,034) as applied to claims 9-10 above and in further view of Brookler (U.S. Patent Application Publication 2002/0007303).**

Regarding claims 11-20, Machin teaches an online benchmarking (survey) system and method including the functional ability to check the validity of data entries by respondents (column 6, lines 10-16).

Marchin does not expressly teach a data structure related to attributes and elements.

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Brookler teaches a system and method for creating survey(s), delivering survey(s), collecting survey results, analyzing survey results, and producing survey/benchmarking reports using extensible markup language (XML).

Official notice is taken that it is old and well known to one of ordinary skill in the art of online surveys and benchmarking that XML describes a data structure of attributes and elements that link related variables and characteristics together (... as are evidenced by the XML Specification Version 1.0 from October 2000) so that an obvious structure is that:

- Question and answer elements have their own attributes (data structure translation... questions and answers have characteristics).
- Question attributes include answer attributes (data structure translation... questions are linked to answers).
- Question attributes include a categorized response attribute (data structure translation... some questions are related and should be considered as a group).
- Question attributes include a verify group attribute and each verify group attribute has a name, test value, and user description (data structure translation... when creating a survey, the questions must in an acceptable format).
- Question attributes optionally include text attributes (data structure translation... some questions have associated text).

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- Answer attributes include a data type and answer description and further include either actual check, verify group, decimal places and units (data structure translation... provide testing criteria to determine acceptable answers given by respondents- see also Machin who functionally teaches error testing of data entries: column 6, lines 10-16).
- Databases are organized by elements and attributes of both questions and answers, then later processed using the same organization (data structure translation... benchmarking survey questions and answers will have their corresponding database file organized by and allow queries by questions and answers).

Brookler is in the analogous art providing a system and method for conducting electronic surveys (or benchmarking studies). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Marchi and Brooklin to create an online benchmarking/ survey method and system that writes in an extensible markup language (XML) structure for efficiency.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Hamlin (U.S. Patent 6,754,635) teaches a method and apparatus/ system for automating surveys over a network system.

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b) Harvard Business Review "Explaining XML" (July-August 2000) teaches the efficiency advantages of the XML protocol in e-business computer applications.


c) Extensible Markup Language (XML) Specification Version 1.0 (October 2000, Section 3 - Logical Structures) teaches the relationship between elements and attributes within the XML protocol framework.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Bylcw whose telephone number is 571-272-8125. The examiner can normally be reached on weekdays, 8AM-5PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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